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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,525	04/26/2006	Peter Moesle	G33-116 US	2223
21706 7590 04/20/2009 NOTARO & MICHALOS P.C. 100 DUTCH HILL ROAD SUITE 110 ORANGEBURG, NY 10962-2100			EXAMINER HANNON, THOMAS R	
			ART UNIT 3656	PAPER NUMBER
			MAIL DATE 04/20/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,525	<b>Applicant(s)</b> MOESLE, PETER	
	<b>Examiner</b> Thomas R. Hannon	<b>Art Unit</b> 3656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 6 and 8, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 7, it is unclear how the claim further distinguishes from claim 1, as claim 1 has been amended to describe the fibers which form a fibrous web.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eibofner US 6,425,761 in view of Allen et al US 4,541,739.

Eibofner discloses a ball bearing (figure 6) for use in dental applications, comprising: an inner race (17) and an outer race (18) coaxial with the inner race, the outer race having a bottom surface on which is provided a groove (47) for accommodating a retaining ring (46) and a cover disk (42), the retaining ring having an inner side and an outer side, and the cover disk being positioned adjacent the inner side of the retaining ring; bearing balls (19) disposed between the

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inner race and the outer race, and a cage (49), wherein the bearing balls are guided by the cage. Eibofner does not disclose the particular material for the cage, nor the precise dimension of the ball bearing diameter, nor the operating speed of the device. With respect to these last two parameters, as the device is for use in dental applications, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the outer diameter of the device within the range claimed. Additionally, it would have been obvious to one of ordinary skill in the art to operate the device within the range claimed.

With respect to the cage material, Allen discloses a ball bearing with an inner race and an outer race (inherent in a ball bearing), with a cage comprised of a composite material of epoxide resin (col. 2, line 61), and fibers (woven mesh 22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cage of Eibofner to be formed of other known materials, including that of a heat cured epoxide resin with fibers formed of a fibrous web, for the desired purpose of improving the lubrication properties as taught by Allen.

With respect to claim 2, there is reason to believe, based on the similarity of material that the functional limitations may be an inherent characteristics of Allen. In accordance with *In re Best*, 562, F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

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Accordingly, the burden is placed upon the applicant to prove that the temperature resistance, pressure resistance, and moisture resistance limitations in question are not inherent characteristics of Allen.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eibofner US 6,425,761 in view of Schwartz US 3,744,862.

Eibofner discloses a ball bearing (figure 6) for use in dental applications, comprising: an inner race (17) and an outer race (18) coaxial with the inner race, the outer race having a bottom surface on which is provided a groove (47) for accommodating a retaining ring (46) and a cover disk (42), the retaining ring having an inner side and an outer side, and the cover disk being positioned adjacent the inner side of the retaining ring; bearing balls (19) disposed between the inner race and the outer race, and a cage (49), wherein the bearing balls are guided by the cage. Eibofner does not disclose the particular material for the cage, nor the precise dimension of the ball bearing diameter, nor the operating speed of the device. With respect to these last two parameters, as the device is for use in dental applications, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the outer diameter of the device within the range claimed. Additionally, it would have been obvious to one of ordinary skill in the art to operate the device within the range claimed.

With respect to the cage material, Schwartz discloses a ball bearing with an inner race (12) and an outer race (11), with a cage (14) comprised of a composite material of epoxide resin (col. 3, line 34), and fibers of a fibrous web (column 3, lines 14-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cage of Eibofner to be formed of other known materials, including that of a heat cured epoxide resin with

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fibers formed of a fibrous web, for the desired purpose of providing a high strength and temperature resistance, as taught by Schwartz.

With respect to claim 2, there is reason to believe, based on the similarity of material that the functional limitations may be an inherent characteristics of Schwartz. In accordance with *In re Best*, 562, F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the temperature resistance, pressure resistance, and moisture resistance limitations in question are not inherent characteristics of Schwartz.

Claims 1-5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eibofner US 6,425,761 in view of Johnson GB 1,215,668.

Eibofner discloses a ball bearing (figure 6) for use in dental applications, comprising: an inner race (17) and an outer race (18) coaxial with the inner race, the outer race having a bottom surface on which is provided a groove (47) for accommodating a retaining ring (46) and a cover disk (42), the retaining ring having an inner side and an outer side, and the cover disk being positioned adjacent the inner side of the retaining ring; bearing balls (19) disposed between the inner race and the outer race, and a cage (49), wherein the bearing balls are guided by the cage.

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Eibofner does not disclose the particular material for the cage, nor the precise dimension of the ball bearing diameter, nor the operating speed of the device. With respect to these last two parameters, as the device is for use in dental applications, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the outer diameter of the device within the range claimed. Additionally, it would have been obvious to one of ordinary skill in the art to operate the device within the range claimed.

With respect to the cage material, Johnson discloses a ball bearing with an inner race (12) and an outer race (11), with a cage (14) comprised of a composite material of epoxide resin (pg. 4, line 78), and fibers of fibrous web (column at page 4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cage of Eibofner to be formed of other known materials, including that of a heat cured epoxide resin with fibers formed of a fibrous web, for the desired purpose of providing a strong and light weight bearing cage as taught and suggested by Johnson.

Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson GB 1,215,668.

Johnson discloses a ball bearing with an inner race (12) and an outer race (11), with a cage (14) comprised of a composite material of epoxide resin (pg. 4, line 78), and fibers (column at page 4). With respect to claim 2, there is reason to believe, based on the similarity of material that the functional limitations may be an inherent characteristics of Allen. In accordance with *In re Best*, 562, F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require

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the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the temperature resistance, pressure resistance, and moisture resistance limitations in question are not inherent characteristics of Allen.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al., Schwartz, and Johnson, individually.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to fabricate the prior art bearings of any known dimension, including those of a "miniature" bearing as claimed.

Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Schwartz US 3,744,862.

Schwartz discloses a ball bearing with an inner race (12) and an outer race (11), with a cage (14) comprised of a composite material of epoxide resin (col. 3, line 34), and fibers (column 3, lines 14-44). With respect to claim 2, there is reason to believe, based on the similarity of



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material that the functional limitations may be an inherent characteristics of Schwartz. In accordance with *In re Best*, 562, F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the temperature resistance, pressure resistance, and moisture resistance limitations in question are not inherent characteristics of Schwartz.

With respect to claim 2, there is reason to believe, based on the similarity of material that the functional limitations may be an inherent characteristics of Allen. In accordance with *In re Best*, 562, F.2d 1252, 195 USPQ 430, 433 (CCPA 1977):

[W]here the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

This "burden of rebutting [may be of] the PTO's reasonable assertion of inherency under 35 USC 102, or of prima facie obviousness under 35 USC 103" (195 USPQ at 432).

Accordingly, the burden is placed upon the applicant to prove that the temperature resistance, pressure resistance, and moisture resistance limitations in question are not inherent characteristics of Allen.

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Applicant's arguments with respect to claims 1-8 10 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas R. Hannon whose telephone number is (571) 272-7104. The examiner can normally be reached on Monday-Thursday (8:30-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard WL Ridley can be reached on (571) 272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas R. Hannon/  
Primary Examiner, Art Unit 3656